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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,403	11/11/2002	Andrew Jonathan Turberfield	480821.90116	2958
7590	11/30/2004			
Quarles & Brady 411 East Wisconsin Avenue Milwaukee, WI 53202-4497			EXAMINER CHEA, THORL	
			ART UNIT 1752	PAPER NUMBER

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,403

Applicant(s)

TURBERFIELD ET AL.

Examiner

Thorl Chea

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/09439 (WO'439) in combination with the applicants' disclosure on page 2, third paragraph; Journal of Vacuum Science & technology B, 1995, vol. 13, no. 6, 30012-3016 (Lee et al) Optics Letters, 1998, vol. 23, no. 22, 1745-1747 (Witzgall et al), and Patil et al (US Patent No. 5,907,333).

WO'439 discloses a method for forming a photonic crystal material having 3-D periodic structure comprising steps as claimed including the suggestion of the use of a high density of photochemically induced cross-linking that is rendered relatively insoluble and retained during development. See the WO'439 as a whole, and especially the abstract, claims 1-19 on pages 17-19, the negative photoresist and cross-linking material on pages 13, lines 18-30.

The WO'439 fails to specifically disclose the photosensitive material possessing an average number of crosslinkable groups per mole at least 3 with an equivalent weight per crosslinkable group at most 1000. However, the claimed photosensitive material has been available in the art and has been used in the formation of 3-D structure. Note to the specification on page 2 lines 15-30 which disclosed that the glycidyl ether of bisphenol A novolac is available as EPON-SU-8 from Shell Chemical, and it has 8 epoxy group per molecule. Witzgall et al discloses the use

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SU-8 film in the process of forming a 3-D structure, and the after exposure, the film was developed by heating to 100 °C for 0.5 h (postbake). See document as a whole. Lee et al discloses the SU-8, a negative-tone photoresist consisting of EPON SU-8 resin from Shell Chemical and photosensitized with triaryl sulfonium, and the photoresist is subject to postbake to a 15 mn postbake on a hot plate for 90-95 °C. See page 312. Patil et al disclose dysfunctional epoxy compound such as EPON-SU-8 and photoinitiator such as onium salt in column 4, lines 14-63. It also disclosed the use of thermal energy during or after exposure to radiation source to accelerate the hardening reaction in column 8, lines 25-30. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to a known photosensitive material such as cross-linking material suggested by WO'439 by a known photosensitive material disclosed in the applicant's disclosure, Lee et al, Witzgall et al or Patil et al in the process taught in the WO'439, and thereby provide a process and material as claimed.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,358,653 (Turberfield) in

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view of the applicants' disclosure on page 2, third paragraph; Journal of Vacuum Science & technology B, 1995, vol. 13, no. 6, 30012-3016 (Lee et al), Optics Letters, 1998, vol. 23, no. 22, 1745-1747 (Witzgall et al), and Patil et al (US Patent No. 5,907,333). The invention claimed in the '653 patent and that of the present claimed invention differs in the selection of the photosensitive, but the section of the crosslinkable photosensitive material would have been found prima facie obvious over the applicants' disclosure on page 2, third paragraph; Journal of Vacuum Science & technology B, 1995, vol. 13, no. 6, 30012-3016 (Lee et al), Optics Letters, 1998, vol. 23, no. 22, 1745-1747 (Witzgall et al), and Patil et al (US Patent No. 5,907,333). See the teachings of each reference in paragraph 4 above. The photoresist such as SU-8 taught in Lee et al can be used in a formation of thick layer and achieve high resolution. Therefore, it would have been obvious to worker of ordinary skill in the art to select the SU-8 in the process of forming 3-D structure claimed in '653 patent for same reason and thereby provide an invention as claimed.

Response to Arguments

5. Applicant's arguments filed on September 9, 2004 have been fully considered but they are not persuasive. The applicants first argue that "the photonic crystal material produced in accordance with the presently claimed method is a holographically defined photonic crystal structure having uniform- 3-dimensional periodicity following exposure to an interference pattern generated by coherent interference of UV laser radiation. The achievement of technical advantages, by using a photosensitive material as defined in present claim 1 such as the resin SU-8, is neither taught nor foreshadowed in the references relied on by the Examiner. Thus the

references do not make it obvious to one skilled in the art that an Su-8-containing resist would be suitable for making photonic crystal structures having the above-mentioned properties.”

It is the Examiner's position that the claimed invention would have been found *prima facie* obvious for the reason set forth in the office action above. The claimed invention is not related to “the method is a holographically defined photonic crystal structure having uniform- 3-dimensional periodicity following exposure to an interference pattern generated by coherent interference of UV laser radiation” asserted by the applicants. See the process in claim 1 which disclosed that “exposing a photosensitive material to an interference pattern of electromagnetic radiation whereby the exposure through the material varies in accordance with the spatially varying intensity created by the interference to produce a three dimensional periodic variation”. This steps is taught is taught in the WO'439 on page 3, lines 21-26. The issue in this case is whether the worker of ordinary skill in the art would have selected a photosensitive material in this process to form a 3-dimentional pattern by selecting a photosensitive material possessing an average number of cross-linkable groups per molecule of at least 3 with an equivalent weight per crosslinkable group of at most 1000. The WO'319 on page 13, lines 18-33 to page 14, lines 1-25 discloses as how to select the photosensitive material including acrylate negative photoresist; a material with a high density of photochemically induced cross-linking which is rendered relatively insoluble and is retained during development; and the positive photoresist based An alternative materials system is a positive photoresist based on a copolymer of p-hydroxystyrene and t-butyl acrylate. WO'439 discloses different types of photoresist including the one having cross-linking group. The worker of ordinary skill in the art would have selected the photoresist material taught therein including the material having photochemically induced cross-linking

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property that have been known and taught in the secondary references with a reasonable expectation of success. The argument with respect to the characteristic of the material is not persuasive since it is not evidenced, and based on the Counsel's assertion. Counsel's arguments cannot take the place of evidence. In re Greenfield, 571 F. 2d 1185, 197 USPQ 227 (CCPA 1978).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tchea 
April 27, 2004

Thorl Chea
Primary Examiner
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